

REMARKS

Summary of the Office Action

Claims 1, 2, and 23 stand rejected under 35 U.S.C. §103(a) as being unpatentable over 5C Digital Transmission Content Protection White Paper (hereinafter “*DTCP*”) in view of U.S. Patent No. 6,678,236 to *Ueki*.

Claims 5-8 and 13-22 stand rejected under 35 U.S.C. §103(a) as being unpatentable over *Ueki*.

Summary of the Response to the Office Action

Applicant proposes amending claims 1-2, 5-8, 13-14, and 19-22. Accordingly, Applicant respectfully requests reconsideration of pending claims 1, 2, 5-8, and 13-23.

The Rejections Under 35 U.S.C. § 103(a)

Claims 1, 2, and 23 stand rejected under 35 U.S.C. §103(a) as being unpatentable over 5C Digital Transmission Content Protection White Paper (hereinafter “*DTCP*”) in view of U.S. Patent No. 6,678,236 to *Ueki*. Applicant respectfully traverses the rejection for the following reasons.

Applicant respectfully submits that newly amended independent claims 1 and 2 include the features of “a secret information is written in advance as the surface shape such as slits and holes, in the region over the substrate other than the data storage region, in order to allow emitted light to pass through the slits and holes and be received by a receiving diode and output as electrical signals.” At least these features are absent from, and are neither disclosed nor taught, alone or in combination, by either *DTCP* or *Ueki*.

The Office bears the initial burden of establishing a *prima facie* case of obviousness. M.P.E.P. § 2142. If the Office fails to set forth a *prima facie* case of obviousness, Applicant is under “no obligation to submit evidence of nonobviousness,” such as unexpected results or commercial success. *Id.* In other words, if the Office fails to meet the initial burden of establishing a *prima facie* case of obviousness as to a given claim, then that claim is not obvious without any evidence of nonobviousness by the Applicant.

To establish a *prima facie* case of obviousness, three basic criteria must be met (see MPEP §§ 2142-2143). First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to combine reference teachings. Second, there must be a reasonable expectation of success. Third, the prior art references must teach or suggest all the claim limitations.

The Office Action has not established a *prima facie* case of obviousness at least because neither *DTCP* nor *Ueki*, whether alone or in combination, teach or suggest all the recited features of newly amended independent claims 1 and 2. Namely, neither *DTCP* nor *Ueki* teach or suggest at least “a secret information is written in advance as the surface shape such as slits and holes, in the region over the substrate other than the data storage region, in order to allow emitted light to pass through the slits and holes and be received by a receiving diode and output as electrical signals,” features recited in claims 1 and 2.

The Office Action states on page 7 that “*Ueki* explicitly discloses storing copy protection information in lead-in areas which include pre-pit area with certain depth (*Ueki*: figure 7 and 9).”

The Office Action asserts that the “lead-in areas” and “pre-pit area” are analogous with the recited “region . . . other than a data storage region” and “slits or corrugations” of the present invention. In *Ueki*, the pre-pit area is recorded in a data storage region (L1 or L2). *Ueki* does not teach the “secret information is written in advance as the surface shape such as slits and holes” as in the present invention. See ¶ [0021] of the specification. The slits and holes are essentially void spaces in the disk. The slits and holes are not the pre-pits as described in *Ueki*. As described in the specification at ¶ [0022], the slits and holes are provided so that light emitted from a diode may be received by a receiving diode and outputted as electrical signals to access the copy protection information. These features are not taught or suggested from the descriptions of *Ueki* provided at col. 1, lines 20 to 63; col. 8, line 62 to col. 9, line 5; and the Abstract as suggested in item 5 of the Office Action. Further, these features are not taught or suggested by the *DTCP* reference.

As pointed out in M.P.E.P. § 2143.03, “[t]o establish prima facie obviousness of a claimed invention, all the claimed limitations must be taught or suggested by the prior art”. *In re Royka*, 409 F.2d 981, 180 USPQ 580 (CCPA 1974). As such, Applicant respectfully asserts that the third prong of *prima facie* obviousness has not been met. Therefore, Applicant respectfully requests that the rejection under 35 U.S.C. § 103(a) should be withdrawn because *DTCP* and *Ueki* do not teach or suggest each and every feature of independent claims 1 and 2.

Additionally, Applicant respectfully submits that dependent claim 23 is also allowable, insofar as it recites the patentable combinations of features recited in claim 2, as well as reciting additional features that further distinguish over the applied prior art.

Claims 5-8 and 13-22 stand rejected under 35 U.S.C. §103(a) as being unpatentable over *Ueki*. Applicant respectfully traverses the rejection for the following reasons.

Applicant respectfully submits that newly amended independent claims 5-8 also include the features of “a secret information is written in advance as the surface shape such as slits and holes, in the region over the substrate other than the data storage region, in order to allow emitted light to pass through the slits and holes and be received by a receiving diode and output as electrical signals.” At least these features are absent from, and are neither disclosed nor taught, alone or in combination, by either *DTCP* or *Ueki*.

The Office Action has not established a *prima facie* case of obviousness at least because *Ueki*, whether alone or in combination, does not teach or suggest all the recited features of newly amended independent claims 5-8. Namely, *Ueki* does not teach or suggest at least ““a secret information is written in advance as the surface shape such as slits and holes, in the region over the substrate other than the data storage region, in order to allow emitted light to pass through the slits and holes and be received by a receiving diode and output as electrical signals,” features recited in claims 5-8.

As indicated above, *Ueki* has different lead-in information that is recorded at portions of different depth of the disk referring to the pre-pit area. Namely, *Ueki* does not teach the secret information is written in advance as the surface shape such as slits and holes as in the present invention. See ¶ [0021] of the specification. These features are not taught or suggested from the descriptions of *Ueki* at col. 1, lines 20 to 63; col. 8, line 62 to col. 9, line 5; and the Abstract as suggested in item 5 of the Office Action.

As pointed out in M.P.E.P. § 2143.03, “[t]o establish prima facie obviousness of a claimed invention, all the claimed limitations must be taught or suggested by the prior art”. *In re Royka*, 409 F.2d 981 180 USPQ 580 (CCPA 1974). As such, Applicant respectfully asserts that the third prong of *prima facie* obviousness has not been met. Therefore, Applicant respectfully requests that the rejection under 35 U.S.C. § 103(a) should be withdrawn because *DTCP* and *Ueki* do not teach or suggest each and every feature of newly amended independent claims 5-8.

Additionally, Applicant respectfully submits that dependent claims 13-22 are also allowable insofar as they recite the patentable combinations of features recited in claim 5-8, as well as reciting additional features that further distinguish over the applied prior art.

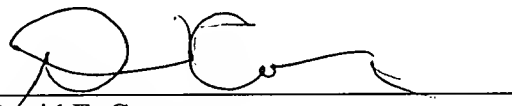
CONCLUSION

In view of the foregoing, Applicant respectfully requests reconsideration and the timely allowance of the pending claims. Should the Examiner feel that there are any issues outstanding after consideration of this response, the Examiner is invited to contact Applicant's undersigned representative to expedite prosecution.

If there are any other fees due in connection with the filing of this response, please charge the fees to our Deposit Account No. 50-0310. If a fee is required for an extension of time under 37 C.F.R. §1.136 not accounted for above, such an extension is requested and the fee should also be charged to our Deposit Account.

Respectfully submitted,

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